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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,639	01/04/2002	Ronald J. Scherer	3616.213US01	9187
23552	7590	10/14/2004	EXAMINER	
MERCHANT & GOULD PC			HECKENBERG JR, DONALD H	
P.O. BOX 2903			ART UNIT	PAPER NUMBER
MINNEAPOLIS, MN 55402-0903			1722	

DATE MAILED: 10/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/038,639	Applicant(s) SCHERER ET AL.	
	Examiner Donald Heckenberg	Art Unit 1722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-35 is/are allowed.
- 6) ☒ Claim(s) 36-41, 43 and 44 is/are rejected.
- 7) ☒ Claim(s) 42 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on January 4, 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: _____ |

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1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on September 29, 2004 has been entered.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicants are advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 36-41, 43, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 196 34 499 (previously of record; hereinafter "DE '499"; reference below will be made to the drawings of this document as well as the English translation previously made of record) in view of Hendrick (U.S. Pat. No. 5,183,616; previously of record).

DE '499 discloses a mold assembly comprising a plurality of side walls (3 and 4) defining a mold cavity (5) with an open top and bottom. The flat surface of a pallet (1) closes the entire

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bottom of the mold cavity (see figs. 1 and 15). The side walls include a converging portion (4) which is mounted so that it is movable between a position at an angle with respect to the vertical so that the mold cavity is wider at its top than it is at its bottom, to a position in which the bottom of the mold cavity is wider at the top of the mold cavity (as shown in fig. 15). The converging portion (4) defines a substantially vertical, planar surface facing the mold cavity and an undercut adjacent to the bottom of the mold, (see fig. 15). DE '499 also discloses the assembly to comprise a mechanism (15) for biasing each of the converging side wall portions to the angled position.

DE '499 further discloses the mold assembly to be provided with a stripper shoe (6) for introduction into the mold cavity through the open top of the mold cavity to press the concrete contained in the mold cavity (see fig. 15).

DE '499 does not disclose the stripper shoe to comprise a three-dimensional pattern, such as simulating natural stone or a flange, to thereby impart the pattern on the molded concrete product.

Hedrick discloses a mold assembly for making concrete products. The assembly comprises a stripper shoe (74) which is introduced into the top of the mold cavities (see fig. 2). The

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stripper shoe includes three-dimensional patterns (90 and 90a) so that the pattern is imparted on the molded concrete (cl. 5, ll. 43-56).

It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to have modified the mold assembly of DE '499 as such to have made the stripper shoe comprise a three-dimensional pattern because this would allow for the pattern to be imparted on the molded product as suggested by Hedrick.

Claims 37 and 38 recite specific patterns to be imparted to the brick. Hedrick notes that it is desirable to make custom bricks with different distinctive patterns (cl. 2, ll. 3-7 & ll. 30-34). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to have modified the apparatus of DE '499 as such to have the stripping shoe comprise distinctive patterns, such as natural stone or flanges at the perimeter, because this would allow for the corresponding distinctive patterns to be imparted to the molded product as desired as suggested by Hedrick.

DE '499 also does not disclose the converging wall portions to extend the entire distance across the mold cavity between the opposed side wall portions. However, DE '499 notes that the converging portion is designed to form an undercut portion in

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the block molded in the assembly, and notes the shape of the converging portion in turn forms the shape of the undercut in the block (see for example, translation p. 9, ll. 13-14 noting that the converging portion 4 forms a triangular undercut). DE '499 is thus clearly relating the converging portion to the ultimate shape produced in the block. Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to have modified the assembly disclosed in DE '499 as such to have the converging portion extended across the entire mold cavity to the opposing side walls because this in turn would have created an undercut extending fully across the block (as desired to form certain shaped blocks) given the correlation of side portion to block shape in DE '499.

6. Applicants' arguments filed September 29, 2004 with respect to the rejection of claims 36-41, 43, and 44 have been fully considered but they are not persuasive.

Applicants argue that there is no teaching or suggestion in DE '499 that the plate 4 should extend across the entire mold cavity so as to shape the entire side of the block between the opposed plates 2. Applicants assert therefore that such a modification would have been obvious could only be based on Applicants' disclosure.

As described above, DE '499 notes that the converging portion is designed to form an undercut portion in the block molded in the assembly, and notes that the shape of the converging portion in turn forms the shape of the undercut block (see for example, translation p. 9, ll. 13-14 noting that the converging portion forms a triangular undercut). Thus, as described above, there is ample suggestion within DE '499 as such to render obvious to one of ordinary skill in the art the modification of the contour plate to extend across the entire mold cavity.

In response to Applicants' argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning in that the only suggestion to modify DE '499 comes from Applicants' disclosure, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, one of ordinary skill in the art would learn from the DE '499 reference that the contour plate forms the shape of

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the undercut. One of ordinary skill in the art would therefore easily be able to conclude that the contour plate modifications of the contour plate results in modifications in the shape of the undercut formed in the molded block. Thus, in the case when an undercut is desired to extend across the entire surface of the block, the contour plate would necessarily be modified to extend across the entire distance of the cavity. As such, one of ordinary skill in the art would not need any reference to the Applicants' disclosure to make such a modification.

Applicants further argue that there is no teaching in DE '499 that the undercut 20 is equivalent to a converging side face portion formed by the claimed converging side wall portion. Applicants assert that as DE '499 discloses the undercut to extend across only a portion of the side of the block, the block is different from that produced by the claimed mold assembly.

These arguments are not persuasive for two reasons. First, as described above, one of ordinary skill in the art would find it obvious to modify the apparatus disclosed by DE '499 as such to have the contour plate extend across the entire width of the mold cavity, therefore the block produced by the mold would have an undercut extending across the entire portion of the mold. Secondly, this argument is directed to product produced by the apparatus, rather than any apparatus structure. As DE '499, in

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combination with Hedrick, suggest all of the apparatus structures recited in the apparatus claims of the instant application, the claims are rendered obvious regardless of the properties of the product being formed by the mold.

7. Claims 24-35 are allowed.


8. Claim 42 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin Utech, can be reached at (571) 272-1137. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



Donald Heckenberg
A.U. 1722